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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/903,500
Filing Date: July 12, 2001
Appellant(s): ECKL, JOHN K.

Michael J. Cummings
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 17, 2005 appealing from the Office action mailed December 14, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

This application was the subject of a previous appeal, for which a previous appeal decision was made on July 14, 2004. The Appellant has attached a copy of this decision as Exhibit B to the Appeal Brief.

Some related issues were under appeal in application 09/289,901, now issued as U.S. Patent 6,829,591 on December 7, 2004.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-11 and 13 have been canceled.

This appeal involves claims 12 and 14-36.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

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(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,802,498	COMESANAS	9-1998
5,699,528	HOGAN	12-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498).

Claims 12 and 18: Comesanas discloses an automated billing system and method comprising:

- a. A billing server to receive billing information (col 2, lines 55-66);
- b. A routing means for processing/routing the information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);
- c. A printer connected to the server (col 3, lines 4-24 and col 4, lines 50-53);
- d. An electronic information server to convert the billing information for electronic transmission and to transfer the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53); and

e. A lookup table containing the delivery preferences from each customer.

While Comesanas does not explicitly disclose that the delivery preferences desired by the customer(s) are maintained in a lookup table, it is inferred that this information is being stored in some type of data file. Since Comesanas explicitly discloses that the system will determine whether each of the debtors has signed an agreement to pay transmittal charges (col 4, lines 44-46)(i.e. selected electronic transmission of the billing invoice) and will determine “whether each of said invoices is to be sent electronically or by mail” (col 4, lines 50-52), it is inherent that the system must look up both preferences, using one of the standard lookup devices in the database arts such as lookup tables.

Comesanas also does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas’ system was being converted to the proper format for printing or electronic transmission.

Claim 14: Comesanas discloses an automated billing system and method as described in Claim 12 above, and further discloses the billing server containing billing information about a plurality of recipients (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

Claim 15: Comesanas discloses an automated billing system and method as in Claim 12 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 17 and 20: Comesanas discloses an automated billing system and method as described in Claims 12 and 18 above and further discloses a means to transmit funds to the biller (col 3, lines 13-24).

Claim 19: Comesanas discloses an automated billing system and method as described in Claim 18 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database. However, Comesanas does not explicitly disclose that the customer's preferences are stored as a lookup table in the database. Official notice is taken that it is old and well known within the database art to place use a table format to save memory space when storing such data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a table to store the customer's selection of delivery means. One would have been motivated to use a lookup table in order to minimize the amount of memory required to store the information for a large number of customers. By placing the data in a table, each customer's file could have a one-bit identifier for the type of delivery instead of a much larger field to store the delivery instructions.

Claims 21, 26, 30, and 32: Comesanas discloses an automated billing system, apparatus, and method comprising:

- a. Accessing billing information comprising a plurality of records (col 2, lines 55-66) corresponding to one recipient;
- b. Isolating each record from the billing information (col 2, lines 55-66);
- c. Extracting delivery preference information from the database for each record (col 3, lines 17-24 and col 4, lines 50-52);
- d. Determining whether each record is intended for printed or electronic transmission based on delivery preference information received from the customer (col 3, lines 17-24 and col 4, lines 50-52);
- e. Converting the billing information for electronic transmission and transmitting the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53);
- f. Routing the billing information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

Comesanas does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas system was being converted to the proper format for printing or electronic transmission.

Comesanas also does not disclose the feature in Claim 30 wherein the switch routes all of the record to the printer if the server fails or is taken out of service. Official Notice is taken that it is old and well known with the communications art to redirect output to another format/device when part of the network fails or is otherwise not available. In this instance, it would have been obvious to one having ordinary skill in the art at the time of invention was made to redirect the electronic bills in the Comesanas invention to the printer and to then transmit the bills through the normal postal channels. One would have been motivated to do so in order to facilitate timely transmission of the bills and receipt of payments, thus decreasing the financial loss to the crediting organization and to the customer (through the levying of "late charges").

Finally, while Comesanas discloses retrieving the customer's billing preference from a database, it is not explicitly disclosed whether this is the same database that contains the billing data or a separate database. Official Notice is taken that it is old and well known within the database arts that data may be stored in one, two, or more databases and then combined as needed. This is referred to as a multidatabase (MDBS) system and has been in use for many years. One of the main advantages of an MDBS is its ability to "access data from a variety of preexisting" (legacy) "databases located in various heterogeneous hardware and software environments." (Korth and Silberschatz, "Database System Concepts", 1991, page 518). It is also common for businesses to store transaction information (billing data) in one file or database and to store customer data (such as name, address, phone, billing and payment preferences, etc.) in a different file or database, and then extract the needed data when compiling

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bills, reports, etc. The two main reasons that this data is kept separate is: (1) to decrease the required storage space by eliminating storing duplicate information, such as the customer's name and address, with each transaction completed during the billing period; and (2) to facilitate updating the customer's data, such as address, by eliminating the need to search for and replace every instance of the data if duplicate data is maintained as in (1) above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain the customer data in the Comesanas invention in a database separate from the billing data. One would have been motivated to maintain separate databases for the reasons discussed above.

Claims 22 and 27: Comesanas discloses an automated billing system and method as described in Claims 21 and 26 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database.

Claims 23 and 34: Comesanas discloses an automated billing system and method as in Claim 21 and 30 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 25, 29, and 36: Comesanas discloses an automated billing system and method as described in Claims 21, 26, and 30 above and further discloses a means to electronically transmit funds to the biller (col 3, lines 13-24).

Claim 31: Comesanas discloses an automated billing system and method as described in Claim 30 above, and further discloses the billing server containing billing information about a plurality of recipients (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

Claim 33: Comesanas discloses an automated billing system and method as described in Claim 31 above, but does not disclose that each record is sanitized. Examiner notes that Applicant has defined "sanitized" in the specification (page 3, lines 24-27) as a filter "which performs a number of convenient functions, such as verifying and/or correcting the accuracy of a customer's address, etc.". Official Notice is taken that it is old and well known within the accounting and database arts to verify and correct data such as addresses, phone numbers, etc. in order to maintain the most up-to-date database as possible. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a means to verify and correct the information within the databases in Comesanas. One would have been motivated to verify and update the information to ensure that the bills are directed to the correct address, thus precluding the wasteful expenditure of time and funds.

(b) Claims 16, 24, 28, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498) in view of Hogan (5,699,528).

Claim 16: Comesanas discloses an automated billing system as in Claim 12 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and

method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas' electronic billing processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to ensure the correctness of the information within the database. Non-receipt and/or non-viewing of the bill could indicate the need to update of the information.

Claims 24, 28, and 35: Comesanas discloses an automated billing system as in Claim 21, 26, and 30 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas' electronic billing processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to ensure the correctness of the information within the database. Non-receipt and/or non-viewing of the bill could indicate the need to update of the information.

(10) Response to Argument

(a) The Appellant argues in reference to independent claims 12, 18, 21, 25, and 30 that Comesanas does not teach or suggest "using the recipient prescribed delivery

preference in order to select printed or electronic delivery techniques" (pages 6-8). The Appellant admits that Comesanas discloses both mail and electronic transmittal means for delivering the billing notices (page 7), but argues that it is the creditor who is choosing the method of delivery, not based on the recipient's billing preference. The Examiner notes that it appears that the Appellant has misconstrued the cited passage from Comesanas (page 7) discussing "an all-electronic business environment" as a business environment in which all billing notices are transmitted electronically. A careful reading of that passage will ascertain that the "all-electronic business environment" is referring to a system in which a recipient who receives the billing notice electronically can pay the billing notice electronically. It does not state or imply that all recipients must receive electronic billing notices. Indeed, Claim 3 of Comesanas explicitly discloses a system which determines if the recipient has indicated the desire to pay for electronic transmittal of the billing notice, to pay for a pre-paid return envelope with a paper billing notice, or neither of the above. Once this determination is made, the system automatically routes the recipient's billing information electronically to the recipient or to a printer for printing and collating the billing notice with the pre-paid return envelope (or regular return envelope if the recipient does not want to pay for the pre-paid return envelope). Thus, while the creditor's system is selecting (determining) the billing method, it is being selected based on whether or not the recipient has selected to pay for electronic or printed billing notices. The Examiner notes that the Appellant's invention and arguments also indicate that the system selects the billing method based

on the stored preferences of the recipient. The above has been previously discussed and confirmed on page 8 of the Board Decision of July 14, 2004.

To further clarify the Examiner's position of how the selection of the billing method in Comesanas is being performed, please note the following. During initial set-up of the recipient's account (or future updates), each recipient will indicate their preferential billing method from one of three possibilities: (1) by mail without a pre-paid return envelope; (2) by mail with a pre-paid return envelope and additional charges on the billing notice for the pre-paid return envelope; or (3) electronically with additional charges on the billing notice for the electronic transmission fee. The recipient's choice is stored and used by the system during each billing cycle to determine how to send the billing notice to the recipient. The system will then automatically direct the billing data to either a printer or to an electronic transmitter.

Therefore, the Examiner believes that Comesanas discloses a system and method for transmitting billing notices in the same manner as the present invention and that the rejection of the claims should be upheld.

(b) The Appellant does not separately argue the features in Claims 16, 24, 28, and 35 against which Hogan was applied, nor the Officially Noted facts in certain dependent claims. Therefore, the Examiner believes these rejections should also be upheld.

(11) Related Proceeding(s) Appendix

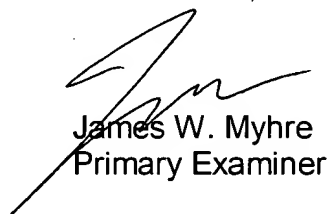
Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



JWM
October 26, 2005



James W. Myhre
Primary Examiner

Conferees:

Eric Stamber

Jeff Carlson

